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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,298	04/14/2004	Haimanot Bekele	9211M	6061
7590 James J. Napoli, Ph.D. Marshall, Gerstein & Borun LLP 233 South Wacker Drive 6300 Sears Tower Chicago, IL 60606-6357			EXAMINER PAGONAKIS, ANNA	
			ART UNIT	PAPER NUMBER
			1614	
			MAIL DATE	DELIVERY MODE
			12/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/824,298

Applicant(s)

BEKELE ET AL.

Examiner

ANNA PAGONAKIS

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 16, 17 and 20-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) _____ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 1-11, 16-17 and 20-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claims 1-11, 16-17 and 20-24 are presented for examination.

Applicant's response filed 10-3-2008 in response to the Final Office Action of 5-13-2008 has been received and entered into the present application.

Upon consideration of Applicant's newly added claims, and further in view of the disparate nature of polymer systems that have been newly added to the claims, the present requirement for election of species is proper.

Applicant is advised that the present requirement will direct further prosecution of the presently pending claims based upon Applicant's election of species to which prosecution on the merits will be restricted.

Requirement for Election of Species

This application contains claims directed to the following patentably distinct species of polymer systems.

The species are independent or distinct because:

The species of polymer systems recited in the present claims are structurally, functionally and/or chemically distinct from any one other polymer compound encompassed by the present claims such that a comprehensive search of the patent and non-patent literature for any one such polymer would not necessarily result in a comprehensive search of any one or more of the other compounds or groups recited in the claims. Additionally, in consideration of the degree of chemical and structural variability of the polymers encompassed by the claims, the disparate nature of polymeric compounds encompassed by this genus precludes a quality examination on the merits, not only because a burdensome search would be required for the entire scope of the claim(s), but also because the consideration of the findings of such a search for compliance with the statutes and requirements set forth under 35 U.S.C. 101, 102, 103 and 112, would be unduly onerous. Furthermore, though

Applicant has recognized a common functionality to the claimed compounds, it remains that the art does not necessarily recognize such a function as being shared by the entire claimed genus of polymers and, as a result, does not necessarily recognize their equivalency or interchangeability. Additionally, it also remains that the art may recognize an advantageous use for the compound in achieving the presently claimed objective that is not necessarily tied to its function in reducing surgical adhesions.

Applicant is required to elect a single disclosed specie of polymer, e.g. one polymer (see instant claims 1-3).

In order for this election to be considered fully responsive to this requirement the election **must include:**

- a) the **name** and **structure** of one species of the instantly claimed compound
- b) the location of the species (a) within the claims or (b) within the specification,
- c) the claims that read on the elected species,
- d) a definition of the exact substitutions,

e.g. R₁ is Hydrogen, X is oxygen, etc...

Applicant is cautioned that the election of a particular specie, wherein the elected specie is not adequately supported by the accompanying specification, may raise an issue of new matter under the written description requirement of 35 U.S.C. 112, first paragraph.

Applicant is advised that a reply to this requirement must include an identification of the elected specie that are elected consonant with this requirement, a structural depiction of the elected specie and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to

additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, Applicant must indicate which are readable upon the elected species. Please reference MPEP §809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though this requirement be traversed (37 C.F.R. 1.143) and (ii) an identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should Applicant traverse on the ground that the inventions or species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNA PAGONAKIS whose telephone number is (571)270-3505. The examiner can normally be reached on Monday thru Thursday, 9am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AP

/Ardin Marschel/
Supervisory Patent Examiner, Art Unit 1614